

CONCEPTION

The Inventor alleges conception of the invention claimed in the Application ("the Claimed Invention") in the United States on a date prior to May 9, 2000, the effective date of the '168 Patent.

FACTS AND DOCUMENTARY EVIDENCE

The following facts are recited in support of the conception allegation:

- 1) The Inventor prepared drawing no. EDK17XXX entitled "MDS Power Guard System" prior to May 9, 2000, which is a conceptualized block diagram of a system embodying the Claimed Invention.
[A-1]
- 2) The Inventor prepared drawing no. PWRGRD2.FLO entitled "Mobile Data System Power Guard" prior to May 9, 2000, which is a more detailed conceptualized block diagram of a system embodying the Claimed Invention.
[A-2]
- 3) The Inventor received a price quote letter dated prior to May 9, 2000, from an outside contractor, Kurt Mihalco of Frontline Technology Corporation, for developing software to be used in the Mobile Data System Power Guard embodying the Claimed Invention. The letter reiterates software implementation tasks requested by the Inventor in a conversation with the software contractor preceding the letter. The software contractor was under an obligation of confidentiality to Palomar Display Products, Inc. ("Display") at the time of the conversation and the letter.
[B-1]
- 4) The Inventor prepared a two-page invention disclosure form ("the Invention Disclosure") entitled "Palomar Display Products, Inc. - Invention Disclosure" on a date prior to June 29, 2000, which includes a written description and a schematic flow chart of the Claimed Invention.
[C-2 - C-3]
- 5) The Inventor transmitted a four-page fax including the Invention Disclosure on June 29, 2000, to Rodney F. Brown, outside patent counsel ("Patent Counsel")

for Display. The fax also includes a one-page Fax Cover written by the Inventor which identifies a system embodying the Claimed Invention by the trademark "Power Guard".

[C-1 - C-3]

- 6) The Invention Disclosure lists a plurality of dates relating to conception of the Claimed Invention under the heading "Dates of Conception". In particular, the Invention Disclosure recites the following dates: 1) "Date first thought of invention"; 2) "Date first written description"; 3) "Date first drawing"; and 4) "Date of first disclosure". Each of the above-recited dates is prior to May 9, 2000.

[C-2]

- 7) Display is the assignee of the Application and the Claimed Invention.
- 8) The Inventor was an independent contractor of Display under an obligation of confidentiality to Display and under an obligation to assign inventions to Display at the time of conception of the Claimed Invention through the filing date of the Application. Chris Lewness, to whom the Claimed Invention was first disclosed, was an employee of Display at the time of disclosure.
- 9) The email to Dinah Thomas, Aaeon Computers, which is referenced in the Invention Disclosure as the first written description of the invention was accidentally destroyed due to a computer storage malfunction and is, therefore, no longer available. Aaeon Computers was under an obligation of confidentiality to Display at the time of the email.

A true copy of the drawing nos. EDK17XXX and PWRGRD2.FLO ("Exhibit A") is attached hereto as documentary evidence in support of Facts 1 and 2 listed above. A true copy of the letter from Kurt Mihalco, Frontline Technology Corporation, ("Exhibit B") is attached hereto as documentary evidence in support of Fact 3 listed above. A true copy of the Fax Cover and Invention Disclosure ("Exhibit C") is attached hereto as documentary evidence in support of Facts 4-6 listed above. Fact 7 is of record in the PTO.

Specific page references within the exhibits are entered in brackets after each Fact 1-6. All actual dates recited in Exhibits A, B and C have been blocked off. Applicant relies on the allegation that the Dates of Conception occurred prior to May 9, 2000.

DILIGENCE

The inventor alleges diligence in the United States from the time just prior to the effective date of the '168 Patent (i.e, just prior to May 9, 2000) up to the date of actual reduction to practice of the Claimed Invention.

FACTS AND DOCUMENTARY EVIDENCE

The following facts relating to actual reduction to practice of the Power Guard System embodying the Claimed Invention by the Inventor and/or Display are recited in support of the diligence allegation:

- 1) The Inventor revised drawing no. EDK17XXX on May 15, 2000, to initiate hardware development of the Power Guard System embodying the Claimed Invention.
[D-1 - D-3]
- 2) The Inventor met with Display coworkers on June 21, 2000, to discuss integration of the Power Guard System embodying the Claimed Invention into a mobile data system for police departments.
[E-1]
- 3) The Inventor expended substantial time leading up to July 6, 2000, preparing a preliminary specification of the Power Guard System embodying the Claimed Invention. On July 6, 2000, the Inventor transmitted the preliminary specification to the Ontario, California Police Department for evaluation in advance of field installation and operation.
[E-2 - E-6]
- 4) The Inventor expended substantial time leading up in July 2000 developing the circuit board layout for the Power Guard System embodying the Claimed Invention. The Inventor met with outside contractors and Display coworkers on July 6, 2000, to discuss the design layout for printed circuit boards of a mobile data system, which includes the Power Guard System embodying the Claimed Invention.
[E-7]

- 5) The Inventor expended substantial time in May through July 2000, overseeing software implementation for the Power Guard System embodying the Claimed Invention. The Inventor transmitted information and an executable example of the software for the Power Guard System embodying the Claimed Invention from the software contractor on July 12, 2000, to the Ontario, California Police Department for evaluation in advance of discussions with the parties.
[B-1; E-8]
- 6) The Inventor completed construction and conducted testing of a prototype of the Power Guard System embodying the Claimed Invention as of August 21, 2000. The Inventor conducted a conference call on August 23, 2000, with the software contractor and the Ontario, California Police Department to solicit input regarding any specific customer needs for the specification and operation of the Power Guard System embodying the Claimed Invention.
[E-9]
- 7) Display received an order for 30 Mobile Data Computers (Item Product Number K17356-100) on October 27, 2000, from the Ontario, California Police Department. Display filled the order for the first 10 units between October 27, 2000 and November 17, 2000. Display shipped the order for the first 10 units on November 17, 2000, to the Ontario, California Police Department.
[F-1]
- 8) The Mobile Data Computer is described in the Bill of Materials for K17356-100 as MDC BLK *PM WIN NT 366/400 MHZ, wherein "PM" refers to "Power Management". The Bill of Materials for K17356-100 shows the Mobile Data Computer including an Item Product Number K17461, which is described as ASSY MDC BASIC 366/400 HZ.
[F-2]
- 9) The Bill of Materials for K17461 shows ASSY MDC BASIC 366/400 HZ including an Item Product Number K17337. Item Product Number K17337 is described in the Bill of Materials for K17461 as PWA PS FILTER *PM, wherein "PS FILTER *PM" refers to "Power Supply Filter Board with Power Management", which is the system embodying the Claimed Invention.
[F-3]

The Facts 6-9 show that the system embodying the Claimed Invention was constructed and demonstrated to achieve its intended purpose as early as August 21, 2000, and no later than November 17, 2000.

A true copy of the revised drawing no. EDK17XXX ("Exhibit D") is attached hereto as documentary evidence in support of Fact 1 listed above. A true copy of emails and related documents transmitted between the Inventor and the recited parties ("Exhibit E") is attached hereto as documentary evidence in support of Facts 2-6 listed above. A true copy of a Sales Order from the Ontario California Police Department and of Display's Bills of Materials ("Exhibit F") is attached hereto as documentary evidence in support of Facts 7-9 listed above. Specific page references within the exhibits are entered in brackets after each Fact 1-9.

It is noted that the date 9/10/04 displayed on the Sales Order is the date that the current copy of the Sales Order was generated. However, the Sales Order was generated from actual historical data stored by Display in electronic form. It is further noted that the Bills of Materials post-date the Sales Order of October 27, 2000. However, the items list in the Bills of Materials have not changed with respect to the relevant items of interest within the time period between the date of the Sales Order and the dates of the Bills of Materials.

TIME OF PRESENTATION OF THE DECLARATION

This declaration is submitted prior to final rejection.

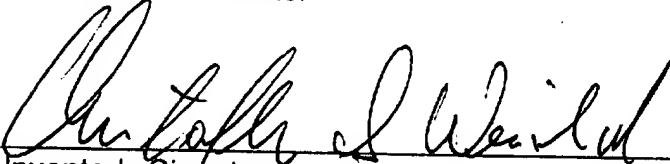
DECLARATION

We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

SIGNATURE

Christoffer S. Weinold
Full Name of Inventor

U.S.A.
Citizenship


Inventor's Signature

9.10.04
Date

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RFB:0910a.035

attachments: Exhibits A-F